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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,849	05/09/2001	Bruce R. David	10420/12	3674

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EXAMINER	
CADUGAN, ERICA E	
ART UNIT	**PAPER NUMBER**
3722	

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/851,849	DAVID ET AL.	
	Examiner	Art Unit	
	Erica E Cadugan	3722	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ they raise the issue of new matter (see Note below);
   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____.
3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.
8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Erica E Cadugan
Primary Examiner
Art Unit: 3722

Continuation of 5. does NOT place the application in condition for allowance because: Regarding the issue of whether of not the proposed amendment to Figure 6 that was filed March 26, 2004 introduces new matter, Applicant has made a number of non-persuasive assertions. Firstly, Applicant has asserted that the "amendment to Fig. 6 added a fastener 58 that was already depicted in as-filed Fig. 8 (also numeral 58)". However, Examiner notes that Figure 8 as originally filed did not show the degree of detail of fastener 58 which Applicant has attempted to provide in the amended Figure 6. Thus, Figure 8 cannot be relied upon as providing support for a teaching of a fastener threaded directly into a workpiece as depicted in the amended Figure 6.
Secondly, Applicant has asserted that "[c]ontrol of torque to a specific installation value requires a nut, because otherwise the amount of torque applied to the bolt or fastener cannot be controlled". However, this is not persuasive. It is noted that a nut is *not* required to provide a specified amount of torque. Specifically, note that in the circumstance shown in amended Figure 6 wherein the bolt is threaded directly into the workpiece, a specified amount of torque can be controlled because, for example, the head of the bolt can be driven against the guide 62, i.e., once, for example, the head of the bolt is driven against the guide 62, continued driving of the bolt causes the threads to attempt to draw in the bolt (further into the workpiece) against the resistance of the interface between the bolt head and the guide, thus providing resistance such that a specified amount of torque can be provided with a torque wrench.

Applicant has further asserted that "a threaded fastener as depicted in amended Fig. 6 is consistent with direct drilling into the skin with no nut" and that "[a]s shown in the specification, control of torque is consistent with a nut, which is not shown or claimed" and finally, has asserted that "[t]hus, the amendment to Fig. 6, adding threads to fastener 58, is consistent with a fastener having a torque-controlling nut as implied in the specification, and is also consistent with a fastener without a nut, as shown in Fig. 6 and as noted by the Examiner". Applicant's point is unclear. It appears that Applicant is asserting that the new matter described in detail on the record in the final rejection mailed June 25, 2004 of the particular type of threaded fastener, i.e., the threaded fastener threaded directly into the workpiece has its support from itself, i.e., appears to be asserting that the amendment is the support for the amendment. Again, Examiner notes that from the teaching in the specification of the fasteners being tightened to a particular value of torque, Examiner agrees that the fastener is inherently some sort of threaded fastener. However, it is *not* inherent from the specification (including the drawings) as originally filed that the particular threaded fastener is of the type that Applicant attempts to show in the amendment to Figure 6 (wherein the threaded fastener threads directly into the workpiece without use of a nut), since the particular type of threaded fastener could also be of a type with a nut. Thus, the teaching of a particular value of torque is not sufficient to provide support for any particular type of threaded fastener, and cannot be relied upon for the support for the amendment to Figure 6. Further note that even though Examiner does not agree with Applicant's assertion that the amount of torque cannot be controlled for a threaded fastener that is threaded directly into the workpiece without the use of a nut, it is noted that even if one assumes arguendo that Applicant is correct, then Applicant would still not have provided support for the amendment to Figure 6 since Figure 6 *shows* a fastener that is threaded directly into the workpiece without a nut (i.e., per Applicant, the specific torque value provides support for a threaded fastener with a nut and not a fastener threaded directly into the workpiece without a nut).

In response to Applicant's assertions about the teachings of the Glover and Hunt references, again, Applicant notes that the rejections in questions were 103 obviousness rejections that did not rely on explicit teachings in Glover or Hunt for the features of the lengths of the fasteners nor the thicknesses of the workpieces. Instead, Examiner supplied reasoning why it would be obvious to have used whatever length of fasteners on whatever thickness of workpiece was desired. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Examiner has set forth reasoning (see the final rejection of June 2004) why one of ordinary skill in the art would have the knowledge required to modify Glover and Hunt as indicated. .